

REMARKS/ARGUMENTS

1. In the above referenced Office Action, the Examiner stated that the response filed on 10/2/03 was not fully responsive for failing to elect a species to be examined. The Examiner further stated that the method claims have already been withdrawn from consideration, however, a second restriction requirement was sent in regard to the several species that are being claimed. The applicant respectfully contends that the second restriction regarding the species is inappropriate and such an election cannot be made based on the species classification offered by the Examiner.

In the office action mailed on 6/27/03 ("the second restriction requirement"), the Examiner stated that this application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Figures 1A - 1B;
Species II: Figures 2A - 2B;
Species III: Figures 3A - 3B;
Species IV: Figures 4A - 4B;
Species V: Figure 5;
Species VI: Figures 6A - 6B;
Species VII: Figures 7A - 7B; and
Species VIII: Figures 8A - 8B.

Applicant is required under 35 USC § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic. The Examiner further acknowledged the applicant's

election of claims 1 - 15 based on the restriction of 8/13/02.

The applicant contends that he cannot make an election to a single disclosed species for prosecution based on the species grouping offered by the Examiner and further contends that he is not required to under 35 USC § 121. In particular, 35 USC § 121 contains no requirements to make an election for a single species for prosecution. 35 USC § 121 does, however, state that "if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Further, 37 CRF § 1.141(a) states, in part, that "more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims..." [emphasis added] Still further, MPEP § 806.04(e) states, in part, "Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments with the breadth and scope of definition (and thus be designated a generic or genus claim)." [emphasis added] Even further, MPEP § 808.01(a) states, in part, that "Election of species should be required prior to a search on the merits (A) in all applications containing claims to a plurality of species with no generic claims, and (B) in all applications containing both species claims and generic or Markush claims."

In the present office action, the species identified by the Examiner are not directed to any particular claim or claims, but to the various figures. Claims 1 - 15 of the


present patent application cannot be individually or collectively restricted to a single figure or figures as suggested by the Examiner. For instance, claim 1 claims an on-chip inductor consisting of at least one dielectric layer, at least one conductive winding on the at least one dielectric layer, and P-well having a major surface parallel to a major surface of the dielectric layer. Figures 1A and 1B illustrate an on-chip inductor having such elements, which, in different embodiments, as shown in Figures 5, 6A, 6B, 7A, and 7B, have the same such elements. The remaining claims have similar issues with respect to the Examiner's species classification.

Given the cited law and/or rules, in light of the above argument, the applicant cannot make a species election based on the Examiner's species classification of the figures. The applicant does contend that whether claims 1 - 15 are individually viewed as generic and/or species claims, an unduly extensive and burdensome search would not be required, which would give rise to a further restriction based on multiple species. As such, a further restriction is not required.

For the foregoing reasons, the applicant believes that further election cannot be made based on the species classification offered by the Examiner.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

RESPECTFULLY SUBMITTED,

By: 
Timothy W. Markison
Registration No. 33,534
Phone: (512) 342-0612
Fax No. (512) 342-1674

CERTIFICATE OF MAILING

37 C.F.R. 1.8

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